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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,300	09/11/2003	Masaya Ogura	03599.000076.	3570

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FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

SKIBINSKY, ANNA

ART UNIT	PAPER NUMBER
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1631

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/659,300	Applicant(s) OGURA, MASAYA	
	Examiner Anna Skibinsky	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 2-7, 10, 12, 13 and 15-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 9, 11 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/27/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Applicants

Applicants amendments to claims 1 and 9 are acknowledged. Claims 1, 8, 9, 11, and 14 are under examination. Claim 25 is withdrawn from examination as it pertains to the subject matter of the non-elected Groups III.

Claim Rejections - 35 USC § 112

The rejection of claim(s) 1, 8, 9, 11, and 14 for being Vague and Indefinite under 35 USC § 112-2nd paragraph in the Office Action filed 7/17/2006 is withdrawn in view of Applicant's Remarks/Amendments filed 11/27/2006.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Othmer et al. (US Patent No. 6,167,358)

3. The instant claims recite a method for identifying the identification of a medical examination device, writing information related to its usage and correlating the

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identification of the device with the information related to its usage. The method then shares and utilizes the information about the device with relevant users.

4. Othmer et al. teach a system and method which can be applied to medical examination devices. The method includes detecting information about a computer based system and relaying it back to server which then communicates the information to a plurality of other computer based systems (Abstract).

5. Claim 1, lines 1-3 and 7-9 recites identifying the identification of a medical examination device and writing down information relating to the usage of the device in a memory.

6. Othmer et al. teaches gathering information about a computer based system over a time interval and transferring the accumulated information back to a central server in order to generate statistics about the frequency of a problem (col. 2, lines 43-52). The system includes generating usage information for each feature in a software application (col. 2, lines 47-49).

7. Claim 1, lines 1-3 and 7-9 and claim 8 recite remotely, through the internet, writing down in memory the additional information related to the usage of the medical examination device.

8. Othmer et al. teaches the server connected remotely to the Internet that permits communication of the computer based systems (col. 4, lines 46-50). The information extracted from the computer based systems which can be medical examination devices such as blood glucose monitor or medical laboratory equipment (col. 4, lines 29-30) is communicated to the server on the network (Abstract and col. 4, lines 43-47).

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9. Claim 1, lines 9-10, and claim 9 recite correlating the identification of the device with the additional information such as a lifetime of the device.

10. Othmer et al. teaches that the set of data, called a black box, particular to the device includes a timestamp that determines the sequence of events prior to the triggering of a certain event (col. 5, lines 26-30). The sequence of events is "a lifetime" of events of the device.

11. Claim 1, lines 10-12 (amendments filed 11/27/2006) recites "identification of the medical examination device, wherein the particular additional information relates to an inspection result and a usage record of the medical examination device."

12. Othmer et al. teaches that the timestamp (i.e. additional information) in the black box allows a user to identify events such as a computer crash (col. 5, lines 26-34). The information in the black box is then sent to the developer who can browse/query the information stored (col. 9, lines 13-21) which is thus also related to the usage of the medical device.

13. Claim 1, lines 13-15, recites sharing and utilizing the information about the device among a plurality of users based on the identification.

14. Othmer et al. teach the sharing and utilizing of the device related information with a plurality of users such as customer service databases, email report generator and query tool (col. 9, lines 5-21). A plurality of users may also include a user receiving solution information and a customer support person (col. 2, lines 57-65).

RESPONSE TO APPLICANTS

15. Applicant's arguments filed 11/27/2006 have been fully considered but they are not persuasive.

Applicants argue (Remarks, page 12, line 22 to page 13, line 4) that Othmer et al. do not disclose the limitations of claim 1, lines 7-12.

16. In response, Othmer et al. do teach correlating the identification of the device with the additional information such as a lifetime of the device.

17. As pointed to in the rejection above, Othmer et al. teaches that the set of data, called a black box, particular to the device includes a timestamp that determines the sequence of events prior to the triggering of a certain event (col. 5, lines 26-30). The sequence of events is "a lifetime" of events of the device.

18. Othmer et al. further teach the limitations of newly added amends in claim 1, lines 10-12 (amendments filed 11/27/2006) which recite "identification of the medical examination device, wherein the particular additional information relates to an inspection result and a usage record of the medical examination device."

19. As pointed to in the rejection above Othmer et al. teaches that the timestamp (i.e. additional information) in the black box allows a user to identify events such as a computer crash (col. 5, lines 26-34). The information in the black box is then sent to the developer who can browse/query the information stored (col. 9, lines 13-21) which is thus also related to the usage of the medical device.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1, 8, 9, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Othermer et al. as applied to claims 1, 8, and 9 above, and further in view of Nova et al. (P/N 6,329,139).

22. Othmer et al. teach a system and method for monitoring a software application on a set of client computers in order to determine information such as defects of usage patterns wherein the system can be medical laboratory equipment (col. 4, lines 19-35). Othmer et al. however do not teach that the system (i.e. medical device) is a DNA micro-array or a DNA chip, as required by claims 11 and 14.

23. Nova et al. however teach matrices with memories as platforms for synthesized compounds wherein the data about the matrices can be tracked (Abstract). The matrices may be silicon chips (col. 31, lines 14-19) and chips or arrays that contain probes (col. 31, lines 31-35). The matrix is marked with a code that is stored in memory and contains information regarding the matrix (col. 54, lines 16-30). The information on the code can be accessed by a remote memory (col. 54, lines 31-51).

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have implemented system and method for monitoring a software application on a set of client computers as taught by Othmer et al. to monitor

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information about DNA microarrays and chips as taught by Nova et al. One of skill in the art would have been motivated to use the method of monitoring information taught by Othmer et al. to monitor DNA chips and microarrays because Nova et al. teach the need for retrieving data regarding the medical device (i.e. chip or microarray) at a distance (Nova et al., col. 66, lines 14-40).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Skibinsky whose telephone number is (571) 272-4373. The examiner can normally be reached on 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.




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